

REMARKS

I. Introduction

Claims 3, 8, 20, 22, 26 and 27 are currently pending in the present application. Claims 3, 22, 26 and 27 were allowed. Claims 8 and 20 have been rejected. Claim 8 has been amended. Entry of amendment to claim 8 is requested since the amendment puts the claim in allowable condition and raises no new issue. It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claim 8 under 35 U.S.C. § 102(b)

Claim 8 has been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,749,262 ("Langer"). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 730 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended independent claim 8 recites, in relevant parts, "one of the optical surfaces, different from the exit surface, of the first optical element is configured as a reflecting surface for bending an optical path." In contrast to the claimed feature, Langer fails to disclose or

suggest that a surface different from the exit surface is configured as a reflecting surface for bending the optical path; instead, the Figure of Langer clearly shows that the exit surface (14b) of the first optical element (14) is used as a reflecting surface.

For at least the foregoing reasons, claim 8 is not anticipated by Langer.

III. Rejection of Claim 20 under 35 U.S.C. § 103(a)

Claim 20 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,749,262 ("Langer"). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim for obviousness under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 20 depends on claim 8. As explained above, Langer clearly does not anticipate parent claim 8. In addition, the Examiner's "Official Notice" clearly does not remedy the deficiencies of Langer as applied against parent claim 8.

For at least the foregoing reasons, the obviousness rejection of pending dependent claim 20 should be withdrawn.

IV. Conclusion

For the preceding reasons, it is respectfully submitted that all the outstanding rejections have been overcome and that the application is in condition for allowance.

Respectfully submitted,

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